

Application No.: 10/658,111
Response dated December 13, 2005
Reply to Office Action of June 15, 2005

REMARKS

Introductory Matter

Applicants wish to thank Examiner Rao for discussing the June 15, 2005 Office Action with applicants' representative, Mr. Roise, by telephone on December 1, 2005. In that discussion, the Examiner and applicants' representative discussed the provisional obviousness-type double patenting rejection in light of the currently pending claims in the present application and U.S. Patent Application No. 10/365,719 ("the '719 application"). The Examiner acknowledged that the present claims are nonobvious over the '719 application and that the provisional obviousness-type double patenting rejection will be withdrawn.

Claim Amendments

Applicants have amended claim 11 to delete the phrase "selected from H" in the definition of R⁴.

This amendment adds no new matter. Its entry is requested.

Withdrawn Rejections/Objections

Applicants acknowledge with appreciation the Examiner's indication that any outstanding rejection/objection not expressly maintained in the June 15, 2005 Office Action is withdrawn or rendered moot.

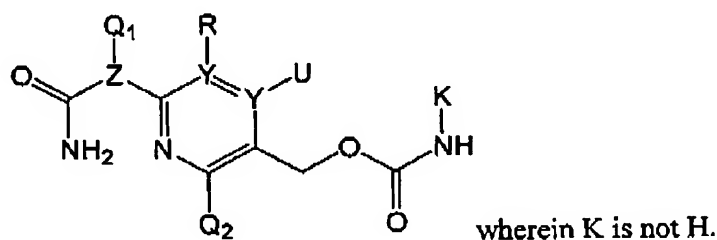
Maintained Rejections

The Examiner has maintained the provisional rejection of claims 11-25 and 30 under the judicially created doctrine of obviousness-type double patenting as being

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unpatentable over claims 1-11, 14, and 20-40 of the '719 application for the reasons presented in the previous office action. There, the Examiner asserted that, "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each another because there is a significant overlap between the instantly claimed genus and the genus of the reference claims." September 30, 2004 Office Action, p. 8. Applicants traverse.

As the Examiner acknowledged in the December 1 interview, the compounds of the present claims and the now-pending claims of the '719 application are patentably distinct. This is so because, unlike the present claims, the pending claims of the '719 application are directed to compounds of formula I(d):



Thus, it would not have been obvious to one of ordinary skill in the art at the time of the invention to select the instantly claimed compounds from those of the genus of the reference claims. Applicants respectfully request that the rejection be withdrawn.

Claim Rejections under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 11-16, 21-25, and 30 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. According to the Examiner, "the claim(s) contains subject matter which was not described in

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the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

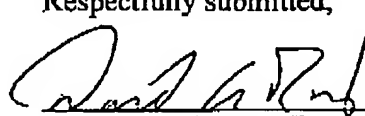
Office Action, page 3. The Examiner contends that the amendment of the definition of R⁴ to recite "H" is not sufficiently supported. Applicants traverse.

Applicants disagree that recitation of "H" in the definition of R⁴ is insufficiently supported in the specification. Solely to expedite prosecution, however, applicants have amended claim 11 to delete the objected-to recitation. Applicants respectfully request that the Examiner withdraw the rejection in light of this amendment.

Conclusion

In view of the above, applicants request that the Examiner enter the amendment, consider the accompanying arguments, withdraw the rejections, and allow the pending claims to pass to issue.

Respectfully submitted,



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